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In re Application of :
Vernon C. Maino et. al. :
Serial No.: 08/803,702 : PETITION DECISION
Filed: February 21, 1997 :
Attorney Docket No.: P-3639P1 :

This is in response to the petition under 37 CFR §1.181, filed June 21, 2006, requesting withdrawal of the holding of non-compliance of the Appeal Brief under 37 CFR 31.37, filed January 24, 2005. The delay in responding to this petition is regretted.

BACKGROUND

A review of the file history shows that a non-final Office action was first mailed on September 16, 1997. The application was subsequently abandoned on June 15, 1998. On March 08, 1999, applicants filed a petition under 37 C.F.R. 1.137(b) to revive an application abandoned unintentionally along with additional claims 20-60. The petition was granted on September 20, 1999. On December 13, 1999, the examiner mailed a restriction requirement. On January 13, 2000, applicants responded by electing group I and the examiner mailed a Final Office action on March 27, 2000.

Applicants filed a CPA on December 12, 2000, to which the examiner responded by mailing a non-final Office action on January 30, 2001. Applicants responded on August 01, 2001 and the examiner mailed a final Office action on August 31, 2001. On January 30, 2002, Applicants mailed an amendment after final, however the examiner did not enter it and mailed an advisory action on February 26, 2002.

Applicants filed a second CPA on July 23, 2002 and the examiner mailed a non-final Office action on December 02, 2002. Applicants responded on March 31, 2003 and the examiner mailed a final Office action on June 13, 2003. Applicants mailed a response on September 03, 2003, indicating that the Final office action was improper and requesting that the finality of the Office action be withdrawn. In response thereto, the examiner withdrew the finality of the Office action and mailed another non-final Office action on October 14, 2003.

Applicants responded on February 17, 2004 and the examiner mailed a final Office action on April 28, 2004. Applicants responded to the final Office action by filing a Notice of Appeal on July 30, 2004. On September 22, 2004, an amendment after final was filed before the Office. On October 14, 2004, the examiner mailed an advisory action to applicants stating that the amendment after final would be entered.

Applicants filed an Appeal brief on November 30, 2004. In response thereto, the examiner mailed a non-compliant notice to the applicants on January 13, 2005, stating that the brief was unsigned and failed to include the name of the registered representative.

To this notice, applicants filed a second Appeal Brief on January 24, 2005.

The examiner mailed a second non-compliance letter on May 22, 2006 indicating that the brief was non-compliant for the reasons given below:

- 37 CFR 41.37 requires a concise explanation of the subject matter defined in each of the independent claims as well as for each dependent claim argued separately, referring to the specification by page and line number. Claims 19, 64, and 65 are summarized.
- note that the 6 page Summary cannot be considered to be "concise" as the majority of it comprises background.
- Further note that many of the page and line number cites do not disclose the steps of the claimed method for which they are cited. For example, page 5, lines 15-17 are cited as disclosing the second step of claim 19. Yet a review of the lines discloses that they merely indicate the concept that the use of agents that block intracellular cytokine secretion enhances their detection when added for a 4 hour incubation. This concept that applies only to a specific time frame, does not describe or support the step of the claimed method for which it is cited.
- Further, it is noted that at page 31, Appellant states that claim 39, which was not separately summarized as would be required, stands only with claim 64 in respect to enablement. Regarding the claims standing or falling together for lack of enablement, at page 25 Appellant states that all the claims on appeal stand or fall together, yet at page 31 Appellant states that claims 39 stand only with claim 64 and at page 32 Appellant states that claim 65 stands alone.

Applicants responded thereto by filing this petition under 37 CFR §1.181, on June 21, 2006, requesting withdrawal of the holding of non-compliance of the Appeal Brief under 37 CFR 31.37, filed January 24, 2005.

DISCUSSION

The requirements under 37 CFR 41.37 for filing an Appeal Brief are as follows:

****>37 CFR 41.37. Appeal brief.**

- (a)
 - (1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.
 - (2) The brief must be accompanied by the fee set forth in § 41.20(b)(2)
- (b) On failure to file the brief, accompanied by the requisite fee, within the period specified in paragraph (a) of this section, the appeal will stand dismissed.
- (c)
 - (1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an

appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(i) *Real party in interest*. A statement identifying by name the real party in interest.

(ii) *Related appeals and interferences*. A statement identifying by application, patent, appeal or interference number all other prior and pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph must be included in an appendix as required by paragraph (c)(1)(x) of this section.

(iii) *Status of claims*. A statement of the status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed.

(iv) *Status of amendments*. A statement of the status of any amendment filed subsequent to final rejection.

(v) *Summary of claimed subject matter*. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(vi) *Grounds of rejection to be reviewed on appeal*. A concise statement of each ground of rejection presented for review.

(vii) *Argument*. The contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown. Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

(viii) *Claims appendix*. An appendix containing a copy of the claims involved in the appeal.

(ix) *Evidence appendix*. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix*. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

(e) The time periods set forth in this section are extendable under the provisions of § 1.136 of this title for patent applications and § 1.550(c) of this title for ex parte reexamination proceedings.<

Under M.P.E.P. Section 1205.03 [R-3], Non-Compliant Appeal Brief and Amended Brief clearly states that the examiner should not require a corrected brief for minor non-compliance in an Appeal Brief.

See below, particularly part B wherein, for example, if the appellant only presents arguments for a dependent claim but not for the independent claim in a group of claims, the examiner can accept the brief and fully explain how the limitations of the independent claims are rejected and address appellant's arguments.

The examiner should not require a corrected brief for minor non-compliance in an appeal brief (e.g., the brief has a minor error in the title of a section heading). The following are a few other examples where the examiner may accept a brief that has minor non-compliance.

(B) If appellant only presents arguments for a dependent claim but not for the independent claim in a group of claims that are subject to the same ground of rejection, the examiner may accept the brief and fully explain how the limitations of the independent claim are rejected and address the appellant's arguments regarding the dependent claim in the examiner's answer.

In the second Notification of Non-Compliance, the examiner states the following:

I. The summary cannot be considered to be concise.

"First note that the 6 page Summary cannot be considered to be "concise" as the majority of it comprises background."

This assessment by the examiner is incorrect as there is no limit to the number of pages that can be a summary.

II. The page and line number cites do not disclose the steps of the claimed method for which they are cited.

"Further note that many of the page and line number cites do not disclose the steps of the claimed method for which they are cited. For example, page 5, lines 15-17 are cited as disclosing the second step of Claim 19. Yet a review of the lines discloses that they merely indicate the concept that the use of agents that block intracellular cytokine secretion enhances their detection when added for a 4 hour incubation. This concept that applies only to a specific time frame, does not describe or support the step of the claimed method for which it is cited."

This assessment by the Examiner is also incorrect. Non-compliance is with respect to formal matters and not to the merits of the subject matter disclosed in the specification.

III. Claim 39 is not separately summarized.

"Further, it is noted that at page 31 Appellant states that Claim 39, which was not separately summarized as would be required"

Applicants do summarize independent claim 39 but only along with claim 64 and applicants have given their reasons for doing so. Again, this is with respect to the merits of the claims and not due to formal matters as is required for a brief to be held not in compliance.

IV. The listing of the groupings of claims that stand and fall together is not consistent.

"Further, it is noted that at page 31 Appellant states that Claim 39 [...], stands only with Claim 64 in respect to enablement. Regarding the claims standing or falling together for lack of enablement, at page 25 Appellant states that all the claims on appeal stand or fall together, yet at page 31 Appellant states that Claims 39 stand only with Claim 64 and at page 32 Appellant States that Claim 65 stands alone."

It can be seen that appellants have grouped the claims together and separately argued three groups of claims. Appellants argue the first grouping of claims is identified in the Appeal Brief at page 25 ("Claims 19-24, 26-33, 35-38, 40-55, and 61-63 stand or fall together with respect to the present rejection."). Appellants argue the second claim grouping which consists of claims 39 and 64, and is identified in the Appeal Brief at page 31. Appellants argue the third claim grouping, which consists of claim 65 and is identified in the Appeal Brief at page 35. Thus, appellants have divided the claims into three sets and never assert that all the claims stand or fall together.

Applicants' arguments set forth in this petition are found to be convincing, and the Appeal Brief appears to be free from non-compliant matters.

DECISION

The petition is **GRANTED**.

The application will be forwarded to the examiner of further consideration not inconsistent with this decision.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number 571-273-8300.



George C. Elliott
Director, Technology Center 1600